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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,717	12/08/2006	William Graves	DEP0721	9858
27777	7590	03/31/2009	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			LAWSON, MATTHEW JAMES	
			ART UNIT	PAPER NUMBER
			3775	
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			03/31/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,717

Applicant(s)

GRAVES ET AL.

Examiner

MATTHEW LAWSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/08/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 01/17/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed January 17, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant fails to supply reference dates for all prior art see CFT 1.98 (b). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet **within the range of 50 to 150 words**. It is important that the **abstract not exceed 150 words in length** since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the threaded shaft portion of claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

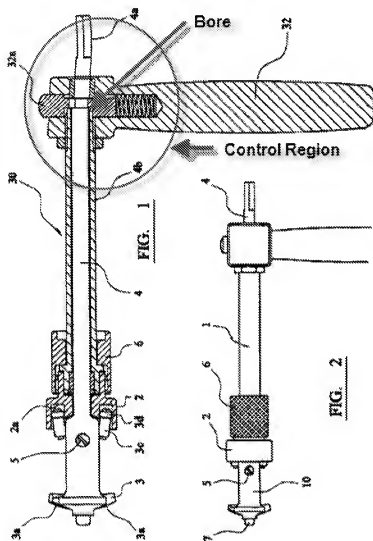
5. Claims 1-10 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sonnabend et al. (WO 01/34040).

Sonnabend et al. disclose a bone resection device having a cutting tool housing (10, figure 2), at least two cutting tools (3, figure 5) which are fastened to the housing so it is capable of being moved reversibly between a retracted position (figure 4) and an extended position (figure 5), in which the cutting tools extended further from the housing in the extended position than in the retracted position. The resection device also having an elongated shaft (4, figure 1) to which the cutting tool housing is attached to at one end; the shaft having a control region (see figure below) at the opposite end and the resection device is controlled while the cutting tool housing is located in the vicinity of the target bone tissue. The device further having a device for controlling the position of the cutting tool 6, figures 1-2) relative to the shaft along the axis of the shaft and is capable of being moved relative to the shaft along the axis defined by the shaft and being capable of rotation relative to the shaft around the axis (page 7, paragraph 2). The controlling device also engages the cutting tool by means of a cam arrangement (2, figure 1-2) in which the cutting tool has an elongated cam track (2a, figure 1) formed in it and the other has a reciprocating follower (3c, figures 1-2) which is capable of sliding in the track, the track being non-parallel to the axis of the shaft (page 7, paragraph 2) so that movement of the control device along the shaft causes relative movement of the follower along the cam track to cause the position of the cutting tool relative to the

housing to change (figures 4-5). The cutting tool is fastened to the housing pivotally so that it is capable of being moved pivotally between retracted and extended positions (figures 4-5, and page 7, paragraph 2), and the cutting tools are fastened to the housing in an opposed manner (figure 5) such that when one of the cutting tools is caused to move in one direction the other cutting tool is caused to move about the same degree in the opposite direction (figure 5). The device further having a handle (32, figure 1) with a bore (see figure below) extending through it in which the shaft is mounted for rotation, and the movement of the control device relative to the shaft is controlled by means of a cam surface (3d, figure 1) extending in a plane generally perpendicular to the axis defined by the shaft and a cam follower, in which one of the cam surface and the follower is fixed relative to the handle, and the other is fixed relative to the control device (6, figure 1), relative rotational movement between the control device and the handle causing the follower to move over the cam surface, and causing relative axial movement between the control device and the shaft (page 7, paragraph 3). The cam surface (3d, figure 1) is provided on the control device (6, figure 1) and the cam follower (3c, figure 1) is fixed relative to the shaft (4, figure 1) and the cam surface is provided on a part capable of being removed from the device. The device includes a locking mechanism (32a, figure 1) for locking the axial position of the shaft relative to the handle, and the locking mechanism further is capable of being adjusted to provide different locked axial positions of the shaft relative to the handle. The shaft also includes a connector formation (4a, figure 1) which is capable of being connected to a drive unit for imparting rotational movement of the shaft (page 7, paragraph 1). The

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cutting tool is generally elongate in shape with a cutting edge (3a, figure 1) towards one end and the cam tracks (3c, figure 1) are opposite each other, the device also includes a protruding boss (7, figure 2) aligned with the shaft and provided on the end which is removed from the shaft (page 7, paragraph 3).



Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son nabend et al. (WO 01/34040) in view of Kuslich et al. (US 6,383,188).

Son nabend et al. discloses the claimed invention except for the shaft having a threaded portion and a locking ring which can be fit onto the threaded portion of the shaft and the device having a spacer ring that can be placed between the threaded portion of the shaft and the locking ring.

Kuslich discloses a bone resection device that has a threaded portion (190, figure 2) and a locking ring (194, figure 2,) which is capable of being fit onto the threaded portion of the shaft (paragraph 33) and has a spacer ring (224, figure 2) which is capable of being placed between the threaded portion of the shaft and the locking ring (paragraph 36) to permit blade advancement within the shaft (paragraph 38). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the device of Son nabend to have the thread portion and locking ring connection with the spacer ring disposed between to permit blade advancement within the shaft as taught by Kuslich.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MATTHEW LAWSON/
Examiner, Art Unit 3775

/Thomas C. Barrett/
TQAS TC3700